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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,905	01/11/2005	Kazuyuki Hasegawa	43890-714	4753
20277 7590 04/17/2008 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096				
EXAMINER				
RAABE, CHRISTOPHER M				
ART UNIT		PAPER NUMBER		
2879				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/520,905

**Applicant(s)**

HASEGAWA ET AL.

**Examiner**

CHRISTOPHER M. RAABE

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/309)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicant's submission, filed January 4, 2008, has been entered and acknowledged by the examiner.

Applicant's arguments filed January 4, 2008 have been fully considered but they are not persuasive.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Slooten (USPN 6229582).

With regard to claim 1,

Van Slooten discloses in at least figure 2 and column 2, lines 50-68 a plasma display panel (PDP) comprising: a dielectric layer (36) covering a scan electrode and a sustain electrode (29s) both formed on a plate (38) and to which a voltage is applied to generate discharge; and a protective layer (21) formed on the dielectric layer (36), wherein the protective layer (21) is made of MgO including silicon (Si) and nitrogen (N). While Van Slooten does not disclose an AC display method, it has been held that when the body of the claim fully sets forth all the limitations of the invention and the preamble merely states an intended use of the invention, the preamble is not considered a limitation.

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With regard to claim 3,

Van Slooten discloses in at least figure 2 and column 2, lines 50-68 a method of manufacturing a plasma display panel (PDP), the method comprising the steps of: forming a dielectric layer (36) to cover a scan electrode and a sustain electrode (29s) both formed on a plate (38) applying a voltage to the scan and sustain electrode in order to generate discharge; and forming a protective layer (21) on the dielectric layer (36), wherein the step of forming the protective layer (21) is a process for forming a film that uses material of the protective layer (21), which material is made of MgO and includes silicon (Si) and nitrogen (N). While Van Slooten does not disclose an AC display method, it has been held that when the body of the claim fully sets forth all the limitations of the invention and the preamble merely states an intended use of the invention, the preamble is not considered a limitation.

With regard to claim 6,

Van Slooten discloses, in at least figure 2 and column 2, lines 50-68 a material of a protective layer of a plasma display panel, wherein the protective layer (21) is formed on a dielectric layer which covers a scan electrode and a sustain electrode (29s) both formed on a plate (38) and to which a voltage is applied in order to generate a discharge, wherein the material is made of MgO and includes silicon (Si) and nitrogen (N). While Van Slooten does not disclose an AC display method, it has been held that when the body of the claim fully sets forth all the limitations of the invention and the preamble merely states an intended use of the invention, the preamble is not considered a limitation.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2,4,7,8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Slooten (as above).

With regard to claim 2,

Van Slooten discloses the PDP as defined in claim 1, wherein the protective layer (21) is made of magnesium oxide (MgO) including Si and N. While Van Slooten does not disclose the concentration falling within the specific ranges claimed in claim 2, it has been held that where the general conditions of a claim are disclosed, it would be obvious to one of ordinary skill in the art to discover the optimum or workable ranges by routine experimentation. While Van Slooten does not disclose an AC display method, it has been held that when the body of the

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claim fully sets forth all the limitations of the invention and the preamble merely states an intended use of the invention, the preamble is not considered a limitation.

With regard to claim 4,

Van Slooten discloses the method of manufacturing a PDP as defined in claim 3, wherein the material of the protective layer (21) is made of magnesium oxide (MgO) including Si and N. While Van Slooten does not disclose the concentration of the Si and N to fall within the specific ranges claimed in claim 4, it has been held that where the general conditions of a claim are disclosed, it would be obvious to one of ordinary skill in the art to discover the optimum or workable ranges by routine experimentation. While Van Slooten does not disclose an AC display method, it has been held that when the body of the claim fully sets forth all the limitations of the invention and the preamble merely states an intended use of the invention, the preamble is not considered a limitation.

With regard to claim 5,

Van Slooten discloses the method of manufacturing a PDP as defined in claim 3, wherein the material of the protective layer (21) is made of magnesium oxide including silicon nitride. While Van Slooten does not disclose the concentration of silicon nitride to fall within the specific ranges claimed in claim 5, it has been held that where the general conditions of a claim are disclosed, it would be obvious to one of ordinary skill in the art to discover the optimum or workable ranges by routine experimentation. While Van Slooten does not disclose an AC display method, it has been held that when the body of the claim fully sets forth all the limitations of the invention and the preamble merely states an intended use of the invention, the preamble is not considered a limitation.

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With regard to claim 7,

Van Slooten discloses the material as defined in claim 6, wherein the material of the protective layer (21) is made of magnesium oxide (MgO) including Si and N. While Van Slooten does not disclose the concentration of the Si and N to fall within the specific ranges claimed in claim 7, it has been held that where the general conditions of a claim are disclosed, it would be obvious to one of ordinary skill in the art to discover the optimum or workable ranges by routine experimentation. While Van Slooten does not disclose an AC display method, it has been held that when the body of the claim fully sets forth all the limitations of the invention and the preamble merely states an intended use of the invention, the preamble is not considered a limitation.

With regard to claim 8,

Van Slooten discloses the material as defined in claim 8, wherein the material of the protective layer (21) is made of magnesium oxide including silicon nitride. While Van Slooten does not disclose the concentration of silicon nitride to fall within the specific ranges claimed in claim 8, it has been held that where the general conditions of a claim are disclosed, it would be obvious to one of ordinary skill in the art to discover the optimum or workable ranges by routine experimentation. While Van Slooten does not disclose an AC display method, it has been held that when the body of the claim fully sets forth all the limitations of the invention and the preamble merely states an intended use of the invention, the preamble is not considered a limitation.

***Response to Arguments***

While the applicant argues that Van Slooten does not disclose a PDP adopting an AC surface discharge method, the applicant asserts that while Van Slooten does not disclose an AC display method, it has been held that when the body of the claim fully sets forth all the limitations of the invention and the preamble merely states an intended use of the invention, the preamble is not considered a limitation. Additionally, while the applicant argues that the voltage applied to electrodes (29) of Van Slooten does not generate discharge, the applicant argues that the voltage applied to these electrodes does generate discharge (in concert with electrodes 31,32).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER M. RAABE whose telephone number is (571)272-8434. The examiner can normally be reached on m-f 7am-3:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nimesh Patel can be reached on 571-272-2457. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CR/

/Mariceli Santiago/  
Primary Examiner, Art Unit 2879